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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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26111 7590 07/26/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			EXAMINER NGUYEN, TANH Q	
			ART UNIT 2182	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/553,397

Applicant(s)

REISMAN, RICHARD R.

Examiner

Tanh Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26, 28-37 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26, 28-37 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2007 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 16-26, 28-37, 39-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has reviewed the sections cited by applicant (page 38, line 22- page 39, line 19; page 53, lines 4-6; pages 53, lines 9-10; page 38, lines 25-26; page

51, lines 9-11; page 51, lines 23-25; page 45, lines 19-21; page 39, lines 7-8) and cannot find support for the following limitations:

“capturing and storing the at least one desired data object from the received broadcast data stream based on said information, on the at least one desired data object's object identifier contained in the broadcast data stream, and on a schedule” - as recited in claims 16 and 28;

“selecting the first one of the plurality of independently operated data sources from **a listing of each of the plurality of independently operated data sources**” - as recited in claims 20-21, 32;

“wherein the method is performed a plurality of consecutive times, wherein during **each time** the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed” - as recited in claim 25; and

“wherein the user station enables a user to access the at least one captured and stored desired data object **while** the user station receives, captures, and stores additional desired data objects” - as recited in claim 36.

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action.

4. Claims 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites “the logic for capturing and storing” in line 2. Claim 48 recites

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"the logic for capturing and storing" in line 2. There is insufficient antecedent basis for the respective limitations in the respective claims.

5. The rejections that follow are based on the examiner's best interpretation of the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 16-19, 23-26, 28-31, 34-37, 39-42, 45-46 are rejected under 35

U.S.C. 102(e) as being anticipated by Joseph et al. (US 5,819,034).

8. As per claims 16-19, 23-26, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and capturing and storing the at least one desired data object from the received

broadcast data stream based on said information, on the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9], and a schedule [the desired data object in the broadcast data stream being repetitive [col. 3, lines 4-7] and on a schedule [col. 10, lines 20-24]].

Joseph further teaches the at least one desired data object being stored in temporary storage at the user station, fetching the at least one desired data object from the temporary storage, preparing the fetched at least one desired data object for use at the user station [col. 5, lines 5-9];

tuning the user station to receive the broadcast data stream [col. 4, lines 54-56];

the at least one desired data object comprising data to which a user at the user station is entitled [entitlement with a cable system [col. 2, line 26; col. 7, line 9];

the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed [col. 5, lines 32-44];

a user at the user station selecting the at least one desired data object to be captured and stored [col. 12, lines 56-65].

9. As per claims 28-31, 34-35, 37, the claims generally correspond to claims 16-20, 23-26 and are rejected on the same bases.

10. As per claim 36, Joseph teaches the user station enabling a user to access the at least one captured and stored desired data object while the user station receives, captures, and stores additional desired data objects [col. 5, lines 32-44].

11. As per claims 39-42, 45-46, Joseph teaches capturing and storing the desired data object according to the schedule (see rejection of claim 16 above) and the method being performed a plurality of times (see rejection of claim 25 above), hence repeating the capturing and storing according to the schedule; an updated version of the desired data object [col. 7, lines 25-28]; and optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 20-21, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al..

Joseph teaches the limitations of claims 16 and 28 above. Joseph further teaches the at least one desired data object being received from (or supplied by) a first one of a plurality of independently operated data sources [channel sources 108, 108A - FIG. 2; col. 9, lines 43-51] and selecting the first one of the plurality of independently operated data sources from the plurality of independently operated data sources [col. 12, line 66-col. 13, line 2; col. 4, lines 54-56], and an application programming interface enabling a software application to select the first one of the plurality of independently operated data sources [col. 12, lines 56-65].

Joseph does not specifically teach selecting a first one of the plurality of independently operated data sources from a listing of the plurality of independently operated data sources.

Since it was known at the time the invention was made to list a plurality of independently operated data sources to make it easier for a user to select an independently operated data source, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so, in order to facilitate the selection by the user.

14. Claims 22, 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al, and in the alternative over Joseph et al. in view of Wagner et al. (US 5,761,602).

Joseph teaches the limitations of claims 16 and 28 above. Joseph does not teach the broadcast data stream being broadcast by Internet multicasting. Since applicant discloses the broadcast information distribution system being an alternative to modem-based wireline or wireless calling to a server; and on the Internet, such broadcasting to a selected group of recipients is called multicasting (page 38, lines 22-27), the use of a broadcast information distribution system or Internet multicasting is not significant, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Internet multicasting in order to practice the Joseph's invention in an Internet environment.

Wagner teaches information from the Internet being multicast to subscribers via a router/distributor [FIG. 1] in order to constantly receive the information without incurring

telephone connection costs [col. 5, lines 65-67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Wagner's teachings into Joseph, in order to avoid incurring telephone connection costs.

15. Claims 43-44, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al..

16. As per claims 43-44, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and capturing and storing the at least one desired data object from the received broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

Joseph further teaches repeating the capturing and storing (see rejection of claim 25 above), an updated version of the desired object (see rejection of claim 40 above), and optionally purging prior versions of the desired data object by a user (see rejection of claims 41-42 above).

Joseph also teaches the method including broadcasting a home shopping show [col. 8, lines 22-25]. Since it was known in the art at the time the invention was made

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for a home shopping show to be scheduled as shown on a TV Guide, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a TV Guide to determine when the home shopping show is on to shop, hence capturing and storing the desired data object in accordance with the schedule of the home shopping show.

Furthermore, since it was known in the art at the time the invention was made to use a revised TV Guide to determine when a show is on, hence fetching a revised schedule to determine when the home shopping show is on in order to shop in accordance with the revised schedule for the home shopping show. Note further that it was known to fetch a TV guide from a broadcast data stream.

17. As per claims 47-48, Joseph teaches optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

18. As per claims 49-50, the claims generally correspond to claims 43-44 and are rejected on the same bases.

Response to Arguments

19. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection and/or not persuasive.

20. With respect to the 112 rejections regarding the limitation recited in claims 16 and 28, applicant cites several sections to support the limitation.

Page 38, line 22-page 39, line 8 is directed to "...capture and hold identified objects...from the broadcast data stream...based on the capability to ...watch for

receipt of data objects identified as relating to...the information product" in the [Receipt of broadcast data] section, and page 39, lines 10-21 is directed to "base user requests for data objects on a schedule" in the [Subscription delivery] section. The support does not appear to be adequate because there is no indication that the receipt of broadcast data is **usable together** with the subscription delivery.

Page 53, lines 4-6 and page 53, lines 9-10 are directed to automatic object retrieval, and does not appear to support schedule driven update of data objects, hence the citations are not relevant to the limitation recited in claims 16 and 28.

21. With respect to the 112 rejections regarding the limitation recited in claims 20-21, and 32, applicant cites several sections to support the limitation. The support does not appear to be adequate because there is nothing disclosing "**a listing** of each of the plurality of independently operated data sources".

22. With respect to the 112 rejections regarding the limitation recited in claim 25, applicant cites several sections to support the limitation. The support does not appear to be adequate because there is nothing disclosing "wherein the method is performed a plurality of consecutive times, wherein during **each time** the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed".

23. With respect to the 112 rejections regarding the limitation recited in claim 36, applicant cites several sections to support the limitation. The support does not appear to be adequate because there is nothing disclosing "wherein the user station enables a user to access the at least one captured and stored desired data object **while** the user

station receives, captures, and stores additional desired data objects".

24. With respect to the 102 rejections, applicant essentially argues that Joseph teaches a schedule as determined by the server, and that applicant's invention is directed to a schedule as requested by the user. The argument is not persuasive because **the claims do not require the schedule as requested by the user**. Note that the features upon which applicant relies (i.e., fetching or the client side handling of data objects based on a schedule ...operating at the user stations, or a schedule at the use station which can be used to regulated future data extraction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

25. With respect to the 103 rejections, applicant argues that Wagner does not specify a schedule as received data at the user station. The argument is not persuasive because Wagner was not relied upon to teach such limitation.

26. Furthermore, since applicant has not traversed any of the well-known statements, the well-known statements have been treated as admitted prior art. See *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TANH Q NGUYEN
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100



July 20, 2007

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